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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/198,427	11/24/98	BRIEDEN	W A32113

BAKER & BOTTS
30 ROCKEFELLER PLAZA
NEW YORK NY 10112-0228

HM22/0628

EXAMINER

MELLER, M	
ART UNIT	PAPER NUMBER

1651
DATE MAILED: 06/28/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/198,427

Applicant(s)

Brieden et al.

Examiner

Michael Meller

Group Art Unit

1651



☒ Responsive to communication(s) filed on May 17, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire one month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-15 is/are pending in the application

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-15 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

This restriction requirement will take the place of the previous requirement.

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-5, drawn to a process of making compound I using compound II, classified in class 544, subclass 277.
 - II. Claims 6 and 7, drawn to a process of making compound I using compounds III and IV, classified in class 544, subclass 277.
 - III. Claims 8 and 9, drawn to a process of making compound V-VIII using a lipase (enzymatically), classified in class 435, subclass 280.
 - IV. Claim 10, drawn to a process of making V-VIII chemically, classified in class 544, subclass various.
 - V. Claim 11, drawn to a process of making IX and X using a hydrolase (enzymatically), classified in class 435, subclass 280+.
 - VI. Claim 12, drawn to a process of making XI and XII using II and IV, classified in class 564, subclass 1.
 - VII. Claim 13, drawn to a process of making XII using II and IV, classified in class 564, subclass various.

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VIII. Claims 14 and 15, drawn to enantiomeric compounds of XIII, classified in class 544, subclass various.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II-VIII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are drawn to patentably distinct processes and compounds. The processes and compounds are not capable of use together since they use different starting materials from each other and they have different modes of operation since the chemical process operates on starting materials and how the reaction is carried out. Since the reactions are carried out in different ways, i.e. enzymatically or chemically which are patentably distinct from one another, then the restriction is proper.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

4. This application contains claims directed to the following patentably distinct species of the claimed invention: the R, X and Y substituents of the chemical compounds of the many processes of the claimed inventions.

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Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 6, 7, 8, 10, 11 and 13 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

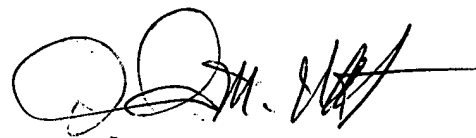
5. A telephone call was made to C. Stephens on 6/22/2000 to request an oral election to the above restriction requirement, but did not result in an election being made.

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Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiries concerning this communication should be directed to Examiner Mike Meller at telephone number (703) 308-4230. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Michael Wityshyn, can be reached at (703) 308-4743. The Fax phone number for the art unit is (703) 308- 0294. Any inquiries of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.


DAVID M. NAFF
PRIMARY EXAMINER
ART UNIT 1651